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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,162

11/26/2003

Makoto Nishimura

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07/17/2006

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WASHINGTON, DC 20006-1021

EXAMINER

KENNEDY, JOSHUA T

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/721,162	Applicant(s) NISHIMURA ET AL.	
	Examiner Joshua T. Kennedy	Art Unit 3679	<i>JK</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) 1,3 and 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-6 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I and Species B in the reply filed on 5/25/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1, 3, 12-14 have been withdrawn.

Claims 7-11 have been cancelled.

Claims 2, 4-6, and 15 have been examined.

Claim Objections

Claim 15 is objected to because of the following informalities:

Line 4: "form" should be --formed--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 4-6, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tetsuo et al (JP Patent 09-060682).

As to Claim 2. Tetsuo et al disclose a tube assembly comprising a first tubular body (2) and a second tubular body (1) disposed such that walls of said first and second tubular bodies overlap (Fig 1), a plurality of joint portions (P) being formed between said first and second tubular bodies by drawing an overlapping part of the walls of said first and second tubular bodies at a plurality of positions (Fig 1), wherein said plurality of joint portions includes at least one first joint portion in which the wall of said first tubular body is laterally extended into the wall of said second tubular body (Examiner considers the dented joint portions to extend laterally into the wall; also, see note below) and at least one second joint portion in which the walls of said first tubular body and said second tubular body are in contact with each other in a cup-like surface configuration (Fig 1; Examiner considers the dent portion to form a cup-like surface).

It is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the joint portions were formed when the joint portions are present. See MPEP § 2113.

Examiner also notes that the specific method of forming is not germane to the issue of patentability of the device itself. Therefore, the limitation "extruded" has been given only limited patentable weight. See MPEP § 2113.

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As to Claim 4. Tetsuo et al disclose a laterally extended shape of said first joint portion (P) into the overlapping part of the walls of said first (2) and second (1) tubular bodies. Examiner again notes that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the joint portions were formed when the joint portions are present. See MPEP § 2113.

Examiner also notes that the specific method of forming is not germane to the issue of patentability of the device itself. Therefore, the limitations "extruded" and "formed by striking a rivet" has been given only limited patentable weight. See MPEP § 2113.

As to Claims 5 and 6. Tetsuo et al disclose said first tubular body (2) forms a support member being selected from a spring seat and a knuckle bracket and said second tubular body (1) forms a tube for a piston-cylinder assembly (Abstract, Lines 6-8).

As to Claim 15. Tetsuo et al disclose an assembly, comprising:

a first body having a first layer (2) and

a second body having a second layer (1), the bodies being disposed such that the first and second layers overlap (Fig 1), a plurality of joint portions (P) being formed between said first and second bodies by drawing an overlapping part of the layers of said first and second bodies at a plurality of positions (Fig 1),

wherein said plurality of joint portions includes at least one first joint portion in which the first layer is laterally extended into the second layer (Examiner considers the

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dent joint portions to extend laterally into the wall; also, see note below) and at least one second joint portion in which the first layer and the second layer are contact with each other in a cup-like surface configuration (Fig 1; Examiner considers the dent portion to form a cup-like surface).

It is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the joint portions were formed when the joint portions are present. See MPEP § 2113.

Examiner also notes that the specific method of forming is not germane to the issue of patentability of the device itself. Therefore, the limitation "extruded" has been given only limited patentable weight. See MPEP § 2113.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patents 6881004 to Handke, 5498096 to Johnson, 5072655 to Adler, 4632592 to Gunter, 3976385 to Klopfer, 6217115 to Downey et al, 4836705 to La Barge et al, 4998337 to Tiekink, 5230136 to Cronn et al, 3973824 to Chor, and US Patent Application 2002/0136593 to Fisher.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTK

JTK
7/7/2006



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